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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,134	08/06/2001	Atle Hedloy	103176-0001C1	9141
24267	7590	02/06/2006	EXAMINER	
CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210			LUU, SY D	
			ART UNIT	PAPER NUMBER
			2174	
DATE MAILED: 02/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/923,134

Applicant(s)

HEDLOY, ATLE

Examiner

Sy D. Luu

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This communication is responsive to the Amendment filed 12/16/2005.
2. Claims 1-~~33~~<sup>34</sup> are pending in this application. Claims 1, 7, 8, 14, 19, 26 and 33 are independent claims. In the instant Amendment, claims 1-21, 23, 25-28, and 30-34 were amended. This action is made Final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claim Objections*

4. Claim 16 is objected to because of the following informalities: the phrase "a the second application" on line 2 should be changed to ---the second application---. Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 8 and 33-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically electromagnetic signals. Electromagnetic signals propagating over a computer network, are not physical "things," nor are they statutory processes, as they are not "acts" being performed. Such claimed electromagnetic signals do not define any structural and functional interrelationships between the electromagnetic signals and

Art Unit: 2174

other claimed aspects of the invention which permit the electromagnetic signals' functionality to be realized. In contrast, a claimed computer - readable medium encoded with electromagnetic signals defines structural and functional interrelationships between the electromagnetic signals and the medium which permit the electromagnetic signals' functionality to be realized, and is thus statutory. See MPEP §2106 Section IV.B.1(a).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 7-12, 14, 16-23, 25-30, and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Tso (U.S. patent 6,085,201).

As per claim 1, Tso teach a method of information handling within a document created using a first application (*e.g. e-mail application 20, at figure 2*), comprising the steps of:

entering a first information in the first application program (col. 4, lines 32- 35);

programmatically analyzing the first information to define search information to be utilized in a second application program (col. 4, lines 48-60; *template engine analyzes the information passed by the first application program*); and

Art Unit: 2174

responding to a user command by inserting into the document a second information from the second application program, the second information associated with the search information (col. 6, line 66 – col. 7, line 2; *template engine 5*).

As to claim 2, Tso teaches the user command to comprise an activation of a device selected from a group consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice command device (col. 3, lines 34-35; col. 4, lines 35-43).

As per claim 3, Tso teaches the following: initializing the second application (col. 4, lines 48-51); searching, using the second application, for the second information associated with the search information (col. 5, lines 7-17); and retrieving the second information (col. 5, lines 42-48).

As per claims 4-5, Tso teaches displaying the second information (col. 5, lines 42-44), and completing the search or second information (col. 6, lines 6-10).

Claims 7-8, 14 are individually similar in scope to claim 1, and are therefore rejected under similar rationale.

Claims 9-12 are similar in scope to claims 2-5 respectively, and are therefore rejected under similar rationale.

As per claim 14, Tso teaches the following subject matter:

entering a first information in the first application program (col. 4, lines 32-35);

programmatically analyzing the first information to define search information for information to be utilized in a second application program (col. 4, lines 48-60; *template engine analyzes the information passed by the first application program*); and

responding to a user command by performing an operation related to a second information, the second information associated with the first information from a second application program (col. 6, line 66 – col. 7, line 2; col. 7, lines 14-25; *template engine 5*).

As per claims 16-18, Tso teaches entering data associated with the search information into the second application program (col. 7, line 19) which is entered by a user (col. 7, lines 14-25), and located within a document (fig. 4; col. 6, lines 6-10).

Claims 19-23 and 25 are similar in scope to claims 1-4, and are therefore rejected under similar rationale.

Claims 26-30 and 32 are similar in scope to claims 1-4, and are therefore rejected under similar rationale.

Claims 33-34 are similar in scope to claims 1 and 4 respectively, and are therefore rejected under similar rationale.

### ***Claim Rejections - 35 USC § 103***

9. Claims 6, 13, 15, 24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso (U.S. patent 6,085,201) in view of Pandit (U.S. patent 5,859,636).

As per claim 6, Tso does not expressly indicate the search information to comprise a name. However, it is known in the art that names are common information being used in an application such as email. For instance, Pandit teaches a method of recognition of text in a body of text and performing an operation relevant to the recognized text (col. 1, lines 51-53), wherein text such as names, email addresses are also recognized. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include Pandit's teaching with the

Art Unit: 2174

invention of Tso because it allows for "transforming the text into an interface to other functions or operations".

Claim 13 is similar in scope to claim 6, and is therefore rejected under similar rationale.

Claim 15 is similar in scope to claim 6, and is therefore rejected under similar rationale.

Pandit further teaches operations comprising creation of one or more of an e-mail, a telex, a fax, or a letter (col. 2, lines 39-41, 58-59; col. 2, line 67 – col. 3, line 8).

Claims 24 and 31 are individually similar in scope to claim 6, and are therefore rejected under similar rationale.

### ***Response to Arguments***

10. Applicant's arguments filed 11/16/05 have been fully considered but they are not persuasive.

Applicants argue the following: (a) the embodiment of electromagnetic signals for transfer of instructions for execution on a process for the practice of a method between computers fully satisfies all requirements of 35 U.S.C. § 101; (b) while Applicant's claimed invention automatically identifies the information to be utilized in the second application program by programmatically analyze the information in contrast to Tso's method which requires that the user define the information to be utilized; (c) Tso's method does not use search information in a second application program to find second information associated with the search information; and (d) Tso does not insert any information into the document from which the original information is located.

The Examiner disagrees for the following reasons.

Art Unit: 2174

Per (a), according to the latest “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” dated October 26, 2006, Section ANNEX (IV)(c) regarding “Computer-Related Nonstatutory Subject Matter” on Electro-Magnetic Signals, on page 57, it is clearly noted that “A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of.” (Emphasis Added). Thus, the rejection under 35 U.S.C. § 101 regarding non-statutory subject matter is maintained accordingly. Note, the “Interim Guidelines...” can be downloaded from the official USPTO website.

Per (b), in Tso’s method, a “software program” is provided to programmatically analyze the information to be utilized as defined by the user beforehand (col. 4, lines 48-60). It is clearly shown that the template engine 5 is the software program that performs this required step as claimed.

Per (c), Tso teaches the second application program (template engine 5) to search for second information associated with the search information (col. 2, lines 7-20).

Per (d), there is only one “original” document in Tso’s method, which is the document described as the reply message. After entering an input text passage, a search is performed by the second application program (template engine) for the associated second information. The associated second information is then inserted into the document from the second application program, wherein the document is the same reply message that the first application program (email application) generated. The details of these features are described in column 2, lines 59 et seq. and column 6, lines 67 et seq.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Inquires***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is **(571) 272-4064**. The examiner can normally be reached on Monday - Friday from 7:300 am to 4:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (571) 272-4063.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Art Unit: 2174

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Sy D. Luu', with a long horizontal flourish extending to the right.

**SY D. LUU**  
**PRIMARY EXAMINER**  
**ART UNIT 2174**